

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 10, 2005. Reconsideration and allowance of the application and presently pending claims 1-65, as amended, are respectfully requested.

1. Present Status of Patent Application

Upon entry of the amendments in this response, claims 1-65 remain pending in the present application. More specifically, claims 1, 4, 11, 17, 21, 40-41, 43, 49, 52, 54 and 60 are directly amended and claims 64 and 65 are added. These amendments are specifically described hereinafter. It is believed that the foregoing amendments and additions add no new matter to the present application.

2. New Title

The Office Action alleges that "the current title 'Document Transmission Techniques I' is not descriptive. The examiner suggests 'Authentication Method in a Printing Environment'. A new title is suggested but not required." In response, the Applicants have amended the title as suggested.

3. Claim Objections

Claim 21 has been objected "because of the following informalities: the examiner believes 'transmitting' as referred to in part c) should be 'receiving.' The system is disclosed so that the printout station receives a document and securely retains it."

In response to the objection, Applicants have amended claim 21 as suggested by the Examiner. Accordingly, Applicants respectfully request withdrawal of the objection.

Applicants appreciate the Examiner's suggestion and his assumption of the intended meaning of claim 21 so that prosecution of the instant case could proceed in a timely manner.

4. Response to Rejection of Claims 1-2, 5-6, 8-11, 13-18, 41-43, 46-48, 54-56, 58 and 60-62 Under 35 U.S.C. §102(b)

In the Office Action, claims 1-2, 5-6, 8-11, 13-18, 41-43, 46-48, 54-56, 58 and 60-62 stand rejected under 35 U.S.C. §102(b) as allegedly being unpatentable by *Mandelbaum* (EP Pat. Pub. No. 0671830A2). For a proper rejection of a claim under 35 U.S.C. Section

102, the cited reference must disclose all elements/features/steps of the claim. See, e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988).

a. Claims 1-2, 5-6, 8-11 and 13-18

Applicants respectfully submit that independent claim 1, as amended, is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest the feature of displaying “receiving and securely retaining a transmitted document at the printout station” and “receiving an independently verifiable data record of the intended recipient at the printout station” as recited in claim 1.

Mandelbaum is apparently limited to at most a system wherein “the header portion of the message is sent unrestricted while the body of the message may be sent either unrestricted (restrict flag 0) or restricted (restrict flag is 1).” (Col. 5, lines 29-33.) Thus, there are two portions of the **single** *Mandelbaum* message, the header and the body. Thus, *Mandelbaum* does not anticipate claim 1, and the rejection should be withdrawn.

Because independent claim 1 is allowable over the cited art of record, dependent claims 2, 5-6, 8-11 and 13-18 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that these dependent claims 2, 5-6, 8-11 and 13-18 contain all features/elements of independent claim 1. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Accordingly, the rejection to these dependent claims should be withdrawn.

b. Claims 41-43 and 46-48

Applicants respectfully submit that independent claim 41, as amended, is allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest the feature of displaying “a communications module for receiving an electronic version of the transmitted document over a communications network, receiving an independently verifiable data record of the intended recipient, and receiving a first token of the intended recipient” as recited in claim 41.

Mandelbaum is apparently limited to at most a system wherein “the header portion of the message is sent unrestricted while the body of the message may be sent either unrestricted (restrict flag 0) or restricted (restrict flag is 1).” (Col. 5, lines 29-33.) Thus,

there are two portions of the single *Mandelbaum* message, the header and the body. Thus, *Mandelbaum* does not anticipate claim 41, and the rejection should be withdrawn.

Because independent claim 41 is allowable over the cited art of record, dependent claims 42-43 and 46-48 (which depend from independent claim 41) are allowable as a matter of law for at least the reason that these dependent claims 42-43 and 46-48 contain all features/elements of independent claim 41. Accordingly, the rejection to these dependent claims should be withdrawn.

c. Claims 54-56, 58 and 60-62

Applicants respectfully submit that independent claims 54 and 60, as amended, are allowable for at least the reason that *Mandelbaum* does not disclose, teach, or suggest the feature of displaying "transmitting the document to the second station" and "transmitting the independently verifiable data record of the intended recipient to the second station" as recited in claims 54 and 60.

Mandelbaum is apparently limited to at most a system wherein "the header portion of the message is sent unrestricted while the body of the message may be sent either unrestricted (restrict flag 0) or restricted (restrict flag is 1)." (Col. 5, lines 29-33.) Thus, there are two portions of the single *Mandelbaum* message, the header and the body. Thus, *Mandelbaum* does not anticipate claims 54 and 60, and the rejection should be withdrawn.

Because independent claims 54 and 60 are allowable over the cited art of record, dependent claims 55-56 and 58 (which depend from independent claim 54), and dependent claims 61-62 (which depend from independent claim 60), are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

5. Response to Rejection of Claims 3-4, 44-45 and 49-53 Under 35 U.S.C. §103

In the Office Action, claims 3-4, 44-45 and 49-53 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Lundblad* (EP Pat. Pub. No. 0542703A1). It is well-established at law that, for a proper rejection of a claim under 35 U.S.C. §103 as being obvious based upon a combination of references, the cited combination of references must disclose, teach, or suggest, either implicitly or explicitly, all

elements/features/steps of the claim at issue. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q.2d 871, 881 (C.C.P.A. 1981).

Applicants respectfully submit that claim 49, as amended, is allowable for at least the reason that the proposed combination of *Mandelbaum* in view of *Auerbach* does not disclose, teach, or suggest at least the feature of “a communications module for receiving an electronic version of the transmitted document over a communications network, receiving an independently verifiable data record of the intended recipient, and receiving a first token of the intended recipient” as recited in claim 49.

Mandelbaum is apparently limited to at most a system wherein “the header portion of the message is sent unrestricted while the body of the message may be sent either unrestricted (restrict flag 0) or restricted (restrict flag is 1).” (Col. 5, lines 29-33.) Thus, there are two portions of the single *Mandelbaum* message, the header and the body. Thus, *Mandelbaum* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

Lundblad also fails to disclose, teach or suggest at least above-recited features of claim 49. *Lundblad* apparently teaches, at most, “a lockable drawer 14” (Col. 3, line 9 and FIG. 1). Thus, *Lundblad* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

Accordingly, the proposed combination of *Mandelbaum* in view of *Lundblad* does not teach at least the above-recited limitations of a claim 49. Accordingly, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* in view of *Lundblad* has not been made. Therefore, claim 49 is not obvious under proposed combination of *Mandelbaum* in view of *Lundblad*, and the rejection should be withdrawn.

Because independent claims 1, 41 and 49 are allowable over the cited art of record, dependent claims 3-4 (which depend from independent claim 1), dependent claims 44-45 (which depend from independent claim 41), and dependent claims 50-53 (which depend from independent claim 49), are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

Additionally, with respect to claims 4 and 50, the Office Action alleges that claims 4 and 50 are obvious under the proposed combination because *Lundblad* “discloses a fax transmission apparatus which includes the use of a locked compartment where documents can be stored until opened by the intended recipient who proves his identity by using a

physical key to unlock the compartment” (Office Action at page 9). However, claim 4 as amended and claim 50 as originally filed recite a controller, not a physical key, that unlocks the compartment. For this reason alone, *Lundblad* does not disclose this feature of claims 4 or 50. Furthermore, this feature is not disclosed in *Mandelbaum*. Accordingly, the feature is not disclosed in the proposed combination of *Mandelbaum* in view of *Lundblad*. Therefore, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* in view of *Lundblad* has not been made, and for at least this reason alone, the rejection should be withdrawn.

Furthermore, physical keys do not, and have never, proven identity. Possession of the key allows the possessor to open the locked compartment. Mere possession of a physical key does not prove identity of an individual under any circumstances. Therefore, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* in view of *Lundblad* by alleging that a physical key proves identity of a person cannot be made, and for at least this reason alone, the rejection should be withdrawn.

6. Response to Rejection of Claims 7, 12, 57 and 63 Under 35 U.S.C. §103

In the Office Action, claims 7, 12, 57 and 63 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum*. Applicants note that no secondary reference is recited in the rejection of claims 7, 12, 57 and 63 under 35 U.S.C. §103(a).

Because independent claims 1, 54 and 60 are allowable over the cited art of record, dependent claims 7 and 12 (which depend from independent claim 1), dependent claim 57 (which depends from independent claim 54), and dependent claim 63 (which depends from independent claim 60), are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

With respect to the rejection of claim 7, the Office Action asserts that “it would have been obvious to one of ordinary skill in the art at the time that the invention was filed to incorporate this authentication method because this is an authentication method *which could be easily implemented* in the system.” (Office Action at page 10, emphasis added.) Applicants respectfully traverse. Issues of patentability are not based upon ease or difficulty of implementing an alleged feature in a system. Applicants note that novelty often lies in using a known feature in a new and novel way, regardless of the ease or difficulty of

implementation. That is, the rejection as worded, is not a legally sufficient basis to reject the features of claim 7. For at least this reason alone, the rejection to claim 7 should be withdrawn.

With respect to the rejection of claims 12, 57 and 63, the Office Action asserts that *Mandelbaum* discloses that "the intended recipient's independently verifiable data record is provided as an intended recipient's digital certificate (Col. 2, lines 38-40)." (Office Action at page 10.) However, the recited portion of *Mandelbaum* discloses that "the recipient inserts his/her smart card into the apparatus and enters a personal security code which is authenticated by the apparatus." This is not a digital certificate as recited in claims 12, 57 and 63, or as disclosed in the Applicants' Specification. At page 15, lines 12-13, the Specification discloses that digital certificates" each contain a copy of a corresponding individual's public key." Thus, the recited digital key does not correspond to the *Mandelbaum* smart card or personal security code as alleged in the Office Action. Furthermore, *Mandelbaum* discloses that the recipient's public key, K_{RP} , is obtained "from Table 401 and Table 402. The restrict and encrypt flags are sent as part of the header message (see Table 403)." Accordingly, *Mandelbaum* fails to disclose, teach or suggest the recited digital certificates of claims 12, 57 and 63. Again, Applicants note the failure to recite a secondary reference in the rejection of claims 12, 57 and 63 under 35 U.S.C. §103(a). Furthermore, no allegation is made that the recited "digital certificate" is known to one skilled in the art. Accordingly, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* has not been made, and for at least this reason alone, the rejection should be withdrawn.

7. Response to Rejection of Claims 19-37 and 59 Under 35 U.S.C. §103

In the Office Action, claims 19-37 and 59 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* (EP Pat. Pub. No. 0798892A2).

a. Claim 21

Applicants respectfully submit that claim 21, as amended, is allowable for at least the reason that the proposed combination of *Mandelbaum* in view of *Auerbach* does not disclose, teach, or suggest at least the feature of "encoding the digital document with a session key using a lightweight symmetric cryptographic encryption algorithm, and

encrypting the session key with the first token using a computationally heavy encryption algorithm” as recited in claim 21.

Mandelbaum does not disclose, teach, or suggest using lightweight symmetric or computationally heavy encryption algorithms. Accordingly, *Mandelbaum* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

Auerbach also fails to disclose, teach or suggest at least the above-recited features of claim 21. Thus, *Auerbach* fails to disclose, teach or suggest every element of the Applicants’ claimed invention.

Accordingly, the proposed combination of *Mandelbaum* in view of *Auerbach* does not teach at least the claimed limitations of lightweight symmetric or computationally heavy encryption algorithms as recited in claim 21. Therefore, a *prima facie* case establishing an obviousness rejection by *Mandelbaum* in view of *Auerbach* has not been made. Thus, claim 21 is not obvious under proposed combination of *Mandelbaum* in view of *Auerbach*, and the rejection should be withdrawn.

b. Claims 19-20, 22-37 and 59

Because independent claims 1, 21 and 54 are allowable over the cited art of record, dependent claims 19 and 20 (which depend from independent claim 1), dependent claims 22-37 (which depend from independent claim 21), and dependent claim 59 (which depends from independent claim 54), are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

8. Response to Rejection of Claims 23 and 24 Under 35 U.S.C. §103

In the Office Action, claims 23 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* in further view of *Lundblad*. Because independent claim 21 is allowable over the cited art of record, dependent claims 23 and 24 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of their respective independent base claim. Accordingly, the rejection to these dependent claims should be withdrawn.

9. Response to Rejection of Claims 38 and 39 Under 35 U.S.C. §103

In the Office Action, claims 38 and 39 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Mandelbaum* in view of *Auerbach* in further view of *Schneier* (Schneier, Bruce. Applied Cryptography. 1996. John Wiley & Sons, Inc. Second Edition. Pages 68-73). Because independent claim 21 is allowable over the cited art of record, dependent claims 38 and 39 (which depend from independent claim 21) are allowable as a matter of law for at least the reason that these dependent claims contain all features/elements of independent claim 21. Accordingly, the rejection to these dependent claims should be withdrawn.

10. Newly Added Claims 64 and 65

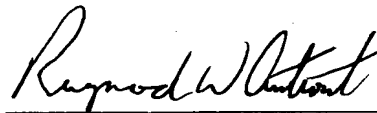
New claims 64 and 65 are based on subject matter that is explicit and/or inherent within the description of the specification and/or the drawings. Applicants submit that no new matter has been added in the new claims 64 and 65, and that new claims 64 and 65 are allowable over the cited prior art. Therefore, Applicants request the Examiner to enter and allow the above new claims.

CONCLUSION

Applicants appreciate the effort on the part of the Examiner in examining the originally filed 63 claims and the effort on the part of the Examiner in preparing a concise and readily-understandable Office Action.

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-65 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,

A handwritten signature in cursive script, reading "Raymond W. Armentrout", written in dark ink.

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